

REMARKS

This amendment addresses the office action mailed September 7, 2004. This amendment amends claims 26-28 and 31-50 and adds new claims 51-62. Claims 26-62 are pending in this case.

The claim amendments are supported by the specification as originally filed and do not add new matter. Support for the new claims 51-62, some of which include features related to the heel cushioning portion, are supported in the original specification at least at the claims as originally filed, page 4, line 27 through page 5, line 9, Figure 3, and at other locations in the specification and drawings.

Examiner Interview Summary

A telephone interview was conducted on December 7, 2004 with Examiner Mohandesi and Applicant's representative Kate DeVries Smith, during which Examiner Mohandesi graciously listened to Applicant's viewpoint on the cited art and pending claims, and articulated the Patent Office position on the rejections. We wish to express our thanks to Examiner Mohandesi for her time in exploring the issues involved in the office action. No agreement was reached. In particular, the lack of an insole receiving area as claimed in claim 26 in Bray '894 was discussed, and the Examiner acknowledged the lack of this particular claimed arrangement in Bray '894.

Claim Objections

Claims 27-28 and 30-50 were objected to as failing to limit the subject matter of a previous claim. Applicants respectfully traverse the rejection. However, claims 27-28 and 30-50 have been amended to clarify their meaning and recite action steps.

Claim Rejections - 35 U.S.C. 103

Claims 26-43 and 47 were rejected under 35 U.S. C. 103 as being unpatentable over U.S. Patent No. 6,226,894 to Bray, Jr. et al. (Bray '894) in view of U.S. Patent No. 6,286,232 to Claims 44-46 and 48-50 are rejected under 35 U.S.C. § 103 as being unpatentable over Bray '894. Snyder '232 and Patterson as applied to claim 26, and further in view of U.S. Patent No.

6,219,941 to Kukoff (Kukoff). Snyder et al. (Snyder '232) and U.S. Patent No. 6,176,025 to Patterson et al. (Patterson). Applicants respectfully traverse the rejection.

Second Lower Density Foam Areas

Claim 26 specifies that the heel cushioning area includes a first higher density foam area, first central lower density foam area substantially surrounded by the first higher density foam area, and a second lower density foam area positioned along a heel perimeter portion. Patterson does not include such an arrangement. Column 3, lines 17-49 of Patterson describes cushioning elements for the sole area 24 and arch area 26 of the footbed 12, illustrated in Figure 2. Then, Column 3, line 59-Column 4, line 39 of Patterson describes cushioning elements for the heel area. All of the cushioning elements in the heel area discussion of Patterson use a flexible shell enclosing an air-gel mixture. The cushioning elements described in Patterson for the heel area of a footbed do not have a first higher density foam area, first central lower density foam area substantially surrounded by the first higher density foam area, and a second lower density foam area positioned along a heel perimeter portion.

Even where Patterson discusses the use of a soft EVA material as a cushioning material in the context of the sole or arch area, such as a Column 3, lines 41-49 of Patterson, it does not describe a first higher density foam area, first central lower density foam area substantially surrounded by the first higher density foam area, and a second lower density foam area positioned along a heel perimeter portion.

Insole receiving area

Bray '894 is relied on by the examiner to teach many of the features of the method, while Snyder '232 and Patterson are relied on by the Examiner related to providing some structural features of the insole. Applicants respectfully submit that Bray '894 does not teach at least the step of placing an insole within an insole receiving area, where an insole receiving area is defined as in claim 1.

Claim 1 includes the step "placing an insole within the insole receiving area." An insole receiving area is defined in claim 1 in the following phrases, "wherein the upper comprises an outsole attachment area attached to an outsole, a foot covering area, and a stabilizing member,

wherein the stabilizing member is attached along the outsole attachment area to provide an insole receiving area between the stabilizing member and the foot covering area". So, the insole receiving area is defined between the stabilizing member and the foot covering area.

In Bray '894 however, the insole 104 is positioned under the sock 109 instead of between the sock 109 and the upper 102. The paragraph starting at col. 7, line 66 of Bray '894 explains how the insole 104 is formed, with sock 109 as its top layer, as shown in Figures 29 and 30 of Bray '894. Then the sock 109 is sewn to the upper 102. See Column 8, line 30 and Figure 34 of Bray '894. Therefore, the components that make up the insole 104 of Bray '894 are positioned under the sock 109 when the sock 109 is stitched to the upper 104. As a result, the insole 104 of Bray '894 is not positioned in an insole receiving area that is defined between a stabilizing member and a foot covering area.

Neither Patterson nor Snyder cure this deficiency. Snyder describes an insole particularly for use during pregnancy and maternity, and does not describe a stabilizing member or foot covering area of a slipper or how the insole would be positioned. Snyder focuses on the structure of an insole for use by golfers and does not describe the structure of the golf shoe with which the insole would be used.

In the Examiner Interview, Examiner Mohandesi acknowledged that as a result of the position of the insole 104 in Bray '894, Bray '894 did not teach this particular limitation of claim 1. Applicants respectfully submit that claim 26 and dependent claims 27-50 are patentable over the cited references for this additional reason.

Height of Foam Areas

Many of the dependent claims also include features that are clearly not taught in the cited references. For example, claim 30 specifies that the higher density foam area has a height that is less than a height of the first lower density foam area. Regarding this and other claims such as 31-32 and 42-43 related to the height of the higher and lower density foam areas, the Examiner argued that these features were an obvious matter of design choice. Applicants respectfully disagree. The Examiner states that a change in size is generally recognized as being within the level of ordinary skill in the art, citing In re Rose, 105 USPQ 237 (CCPA 1955). Rose states,

"Appellant argues that this claim recites that the package is of appreciable size and weight so as to require handling by a lift truck whereas Wheless and Denison packages can be lifted by hand. We do not feel that this limitation is patentably significant since it at most relates to the size of the article under consideration which is not ordinarily a matter of invention." Rose at 240. However, in the claims 30-32 and 42-43 it is not merely the size of an article that is being claimed, but the relative size of two portions of an article. The difference in height between the higher and lower density foam areas is not merely the size of an article. The height difference is discussed in the specification of the present application as providing the advantage of providing visual interest for a customer of the slipper and may cause the customer to examine the slipper 10 more closely. The Applicants respectfully request that the rejection of claims 31-32 and 42-43 be withdrawn, and that a specific reference be provided for teaching the claimed features if the rejection is maintained.

Isolated Lower Density Foam Areas

Claim 34 specifies that insole is formed so that the first lower density foam area is surrounded by a plurality of isolated lower density foam areas wherein the plurality of isolated lower density foam areas are separated from each other by portions of the first higher density foam area. The Office Action refers to Figure 3 and column 4, lines 28-33 as describing these features. However, Figure 3 of Patterson shows a gel-air cushioning element, and therefore does not teach the claimed step of compression molding a foam layer to provide a first lower density foam area surrounded by a plurality of isolated lower density foam areas wherein the plurality of isolated lower density foam areas are separated from each other by portions of the first higher density foam area. As a result claim 34, and also claims 54 and 58, are clearly further patentable over the cited art.

Unitary Piece of Foam

Claim 33 specifies that the insole the compression molding step is carried out on a unitary piece of foam to create the insole, so that the first high and low density foam areas are part of the unitary piece of foam. This feature is also not taught in the cited references and accordingly this claims should be allowed for this additional reason.

New Claims

New claim 51 specifies that the heel cushioning portion includes a first higher density foam area and a first lower density foam area, wherein the first lower density foam area projects above the surface of the first higher density foam area on the first foam side, having a difference between the height of the first lower density foam area and the first higher density foam area of at least 1/16 inch. Also, new claim 51 specifies that the insole is placed within the insole receiving area with the first foam area facing the foot covering area.

New claim 58 specifies that the heel cushioning portion includes a first higher density foam area and a first lower density foam area that is surrounded by the first higher density foam area, wherein the first lower density foam area is surrounded by a plurality of isolated lower density foam areas, and the plurality of isolated lower density foam areas are separated from each other by portions of the first higher density foam area.

Applicants respectfully submit that the new claims 51-62 are in condition for allowance.

Conclusion

The Examiner is encouraged to contact Applicants' undersigned representative if such contact would be helpful in any way. A Notice of Allowance at an early date is respectfully requested.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: January 7, 2005



Katherine M. DeVries Smith
Katherine M. DeVries Smith
Reg. No. 42,157
KDS:PLSdb